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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/656,028 | 09/04/2003 | Troy J. Tranter | B-379 | 8489 |
| 7590 Stephen R. Christian BBWI PO BOX 1625 IDAHO FALLS, ID 83415-3899 | | | EXAMINER JOHNSON, EDWARD M | |
| | | | ART UNIT 1754 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/656,028

Applicant(s)

TRANTER ET AL.

Examiner

Edward M. Johnson

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Appeal Brief

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn to make a different rejection over the same reference.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-16 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruening et al. US 6,232,265.

Regarding claims 1 and 25, Bruening '265 discloses a method for making a selectively binding particulate composition comprising dissolving a mixture of pentaerythritol and Ag/KOH catalyst, adding acrylonitrile and pouring into water; and polymerizing (see Example 3). The formation of an adsorption medium would be inherent in making the prior art product.

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Bruening '265 fails to disclose PAN in the adsorption medium.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use PAN because one of ordinary skill would expect at least some polymerized acrylonitrile and KOH to remain in the disclosed selective binding composition.

Regarding claims 2-5, 8, and 10-12, Bruening '265 discloses Ag/KOH solution (see Example 3).

Regarding claim 7, Bruening '265 discloses nitric acid (see Example 12).

Regarding claims 13-15, Bruening discloses a solid bead support and passing the solution over a column of the particles (abstract).

Regarding claims 26-27, Bruening '265 discloses metal oxides (see claim 4) and pouring into water (see Example 3).

Regarding claim 22, Bruening '265 discloses 42.45g polymerized acrylonitrile, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use 10-85% elemental metal because Bruening '265 discloses 40% Ag/KOH, and removal by filtration, which would obviously, to one of ordinary skill, motivate 10-85% of Ag after removal of liquid by filtration with a balance of polyacrylonitrile.

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Regarding claim 6, Bruening discloses magnesium sulfate (see Example 3) and acetic acid (Example 2), which would at least suggest a sulfate or acetate anion.

Regarding claim 9, Bruening discloses 0.80 mole acrylonitrile and 0.10 tetranitrile (see Example 3).

Regarding claims 16 and 23-24, Bruening '265 discloses 40% Ag/KOH, and removal by filtration, which would obviously, to one of ordinary skill, at least motivate 10-85% of Ag after removal of liquid by filtration with a balance of polyacrylonitrile.

Response to Arguments

4. Applicant's arguments filed 6/9/06 have been fully considered but they are not persuasive.

It is argued that the Examiner asserts that Bruening discloses... and polymerizing. This is not persuasive because Applicant appears to suggest that polyacrylonitrile cannot be present in "fibers" and "rubber", or that they are somehow mutually exclusive. However, such an assertion appears unsupported by the record. Bruening discloses adding acrylonitrile and pouring into water; and polymerizing (see Example 3). Thus, polymerized acrylonitrile would have been obvious to an ordinarily skilled artisan in view of the prior art disclosure of both acrylonitrile and polymerization.

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It is argued that the Examiner also asserts that... *Id.* At pp. 5 and 7. This is not persuasive because it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, it would have been within the purview of one having ordinary skill in the art to use polymerized acrylonitrile because Bruening discloses allowing acrylonitrile to "polymerize completely" (see Example 3, column 9, lines 30-35).

It is argued that furthermore, Applicants maintain that Bruening does not teach... required by independent claim 25. This is not persuasive for the reasons above and also because Applicant appears to admit that "adsorption" is merely an intended use. Bruening '265 further discloses Ag/KOH solution (see Example 3). Thus, both polymerized acrylonitrile and metal hydroxide are disclosed.

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It is argued that regarding independent claim 22... "polymerized acrylonitrile". This is not persuasive for the reasons above.

It is argued that furthermore, the Examiner states that it would have been obvious... a balance of polyacrylonitrile. This is not persuasive because it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Edward M. Johnson
Primary Examiner
Art Unit 1754

EMJ